

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:

U. S. Patent No. 6,609,975 issued August 26, 2003

Applicants: Thomas E. SAWYER, et al.

Confirmation No. 6772

Serial No.: 08/918,944

Art Unit: 3714

Filed: August 25, 1997

Examiner: SAGER, M.

For: ELECTRONIC SYSTEM AND  
METHOD FOR OPERATING AN INCENTIVE AUXILIARY GAME

Atty. Docket No.: Ten Stix '975

**PETITION TO REQUEST ACCEPTANCE OF A MAINTENANCE FEE DUE AFTER  
EXPIRATION OF U.S. PATENT NO. 6,609,975, PURSUANT TO RULE 378 AND  
RULE 20 (i)(1) UNAVOIDABLE**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Mailstop: Petition

Sir:

This is a Petition to the Director to request acceptance of late payment of a maintenance fee which would have been due February 26, 2007, or August 26, 2007 with a surcharge, for U. S. Patent No. 6,609,975, issued August 26, 2003. The fee due per Rules 20(e) and 20(h) is calculated at \$535.00 including \$490.00 for the 3 ½ year maintenance fee plus a \$65.00 surcharge for late payment (small entity). A total fee of \$1235.00 is being paid by credit card. The total fee includes the total maintenance fee due of \$535.00 with surcharge and a fee of \$700.00 due for this Petition pursuant to Rule 20(i)(1).

Also, enclosed please find affidavits submitted in support of this Petition by:

1) Tony Cranford, President, Ten Stix Gaming Inc., 12252 West Chenango Drive, Morrison, CO 80465 (formerly known as TEN STIX, INC. of 3101 Riverside Dr., Idaho Springs, CO 80452) ("Ten Stix");

2) Thomas H. Jackson, Esq., the undersigned attorney, presently of the PCT Law Group (Customer no. 75396), which firm currently holds power of attorney in pending patent matters for Ten Stix;

3) Wilburn Chesser, Esq., of Arent Fox LLP, formerly of record during the prosecution of the above-identified U.S. Patent No. 6,609,975, which has expired for failure to pay the 3 ½ year maintenance fee when due; and

4) James Bindseil, Esq., of Arent Fox LLP, to whom a prosecution and correspondence file for the above-identified application of Ten Stix was transferred in approximately August of 2006.

The Office is authorized to charge any additional fees due or credit any overage for this filing to our deposit account no. 504-462.

#### **FACTS DEMONSTRATE THAT THE UNAVOIDABLE STANDARD IS MET**

Facts and evidence are submitted in the form of the above-identified affidavits and exhibits attached thereto in support of this Petition. These affidavits and exhibits establish that the failure to pay the maintenance fee when due was unavoidable, for example, by reason of Mr. Cranford's not having any personal knowledge or any business records that either he or Ten Stix were knowledgeable that a maintenance fee was due and payable during the maintenance fee window, opening August 26, 2006 and closing August 26, 2007. Indeed, Mr. Cranford's testimony is that he first learned of the expiration of U. S. Patent No. 6,609,975, (the '975 patent) on or about February 8, 2010, after inquiring about the status of the '975 patent to Mr. Jackson.

Moreover, Computer Patent Annuities, now CPA Global, to whom maintenance fee responsibility was delegated by Mr. Wilburn Chesser after the '975 patent issued, has no record of ever receiving any reply from Ten Stix or Mr. Cranford to renewal notices. (Exhibit 2, Jackson Affidavit). Computer Patent Annuities received the only Notice of Expiration mailed September 24, 2007, according to the file wrapper for U. S. Patent No. 6,609,975, and as retrieved from the United States Patent Office, Franconia deposit site, by LandonIP of Alexandria, Virginia, at the request of Mr. Jackson. (Exhibit 3, Jackson Affidavit; Exhibit 2, Chesser Affidavit). Consequently, Mr. Cranford, being unaware of the maintenance fee due

until February of 2010, Mr. Cranford, as soon as reasonably possible after learning of the expiration of the '975 patent, submits this Petition. Further facts as supported by the affidavits and exhibits attached hereto are discussed below.

Mr. Tony Cranford

Mr. Cranford states that he only first became aware that Ten Stix Gaming's U.S. Patent No. 6,609,975 had expired for failure to pay the 3 ½ year maintenance fee when due in e-mail correspondence between himself and the undersigned, Thomas Jackson, Esq. of the PCT Law Group, on or about February 8, 2010. (Paragraph 3 and Exhibit 1, Cranford Affidavit). Mr. Cranford would have paid the maintenance fee when due or as soon as he learned such fee was due because both Tony Cranford and his then partner, Thomas Sawyer, of Ten Stix entered into a business relationship in July of 1997 with DEQ Casinos Int., now DEQ Systems Corp., (DEQ), a small entity, of Levis, QC, Canada (Paragraph 5, Cranford Affidavit). Mr. Cranford generally describes the business relationship as relating to the sharing of patents, patent applications and technology under development (the technology) between the entities so that they could share the technology (Paragraph 5, Cranford Affidavit). Mr. Cranford has performed a diligent search of personal and Ten Stix business records and has found no correspondence or any other record of ever receiving any correspondence related to the payment of the maintenance fee due in respect to the '975 patent. (Paragraphs 9 and 10, Cranford Affidavit).

Moreover, Mr. Cranford and Mr. Sawyer, named co-inventors, were at the time of entering the business relationship with DEQ in July of 1997 partners in the operation of Ten Stix and cooperated as co-inventors of technology disclosed during the prosecution of the application filed August 26, 1997, which later issued as U. S. Patent 6,609,975. (Paragraph 6, Cranford Affidavit). However, Mr. Cranford and Mr. Sawyer parted company in approximately January of 2006, before the maintenance fee was due. (Paragraph 7, Cranford Affidavit). Mr. Cranford purchased Mr. Sawyer's interest in Ten Stix Gaming Inc. and in the '975 patent in approximately January of 2006. Mr. Cranford relocated Ten Stix to Morrison, CO from Idaho Springs, CO, then to Lakewood, CO and back to Morrison, CO. (Paragraph 7, Cranford Affidavit). Consequently, ownership and management of Ten Stix Gaming Inc. since 2006 have been with Mr. Cranford. (Paragraph 7, Cranford Affidavit). Mr. Cranford and his former partner, Mr. Sawyer, have not communicated on business matters since 2006. (Paragraph 8, Cranford

Affidavit). Mr. Cranford, upon personal recollection and upon information and belief, never learned of any maintenance fee being due from his ex-partner, Mr. Sawyer. (Paragraph 8, Cranford Affidavit). As already discussed above, Mr. Cranford only first became aware that Ten Stix Gaming's U.S. Patent No. 6,609,975 had expired for failure to pay the 3 ½ year maintenance fee when due in e-mail correspondence between himself and the undersigned, Thomas Jackson, Esq. of the PCT Law Group, on or about February 8, 2010. (Paragraphs 3, 9 and 10, Cranford Affidavit).

Mr. Thomas Jackson

Mr. Jackson states in his affidavit that the PCT Law Group has been responsible for Ten Stix patent application preparation and prosecution since approximately November of 2008. (Paragraph 3, Jackson Affidavit). Mr. Jackson on February 8, 2010, received an e-mail from Mr. Cranford requesting the status of the '975 patent and, learning of the expiration of the '975 patent for failure to pay the 3 ½ year maintenance fee when due, reported the same by e-mail to Mr. Cranford. (Paragraph 4 and Exhibit 1, Jackson Affidavit). Upon his return to the office after an unprecedented snow storm in the Washington, DC area in February, 2010, Mr. Jackson conducted a thorough search of the PCT Law Group Offices to locate any business records comprising any correspondence or patent file related to the prosecution of the above-identified application resulting in issuance of US 6,609,975 or to its expiration. Mr. Jackson found no such file. (Paragraph 6, Jackson Affidavit). Mr. Jackson requested Mr. Cranford to diligently search for any business records of Ten Stix directed to the '975 patent. (Paragraph 7, Jackson Affidavit). Mr. Jackson further inquired of Wilburn Chessier, Esq., of Arent Fox LLP if any such file was in the possession of Arent Fox LLP. (Paragraph 7, Jackson Affidavit).

Moreover, Mr. Jackson, on February 16, 2010, made inquiry on behalf of Mr. Cranford and Ten Stix of CPA Global (formerly Computer Patent Annuities), with Mr. Cranford's permission, to determine if CPA Global could recover any business records related to the payment or lack thereof of a maintenance fee in re US Patent No. 6,609,975. (Paragraph 9 and Exhibit 2, Jackson Affidavit). Ms. Jennifer Lopez of CPA Global replied by e-mail of February 23, 2010. Her e-mail indicates that CPA transmitted four renewal notices to Ten Stix and, never receiving a reply, allowed the patent to lapse. The dates of the renewal notices are 22 Sep 2006; 22 Nov 2006; 22 Mar 2007 and 21 July 2007. (Exhibit 2, Jackson Affidavit).

Mr. Jackson, on or about February 17, 2010, further made inquiry of Mr. James Bindseil of Arent, Fox, LLP, to determine if any correspondence or file exists related to US 6,609,975, at any firm with which he was associated during the period of his handling Ten Stix patent application matters. (Paragraph 8, Jackson Affidavit).

On or about March 11 2010, Mr. Jackson ordered from Landon IP, an IP service company in Alexandria, Virginia, a complete copy of the file wrapper for the above-identified application resulting in the '975 patent. Mr. Jackson distributed electronic copies of the '975 patent file wrapper to Mr. Chesser and to Mr. Bindseil for review and personally reviewed the file wrapper. (Paragraph 10, Jackson Affidavit). Upon review of the file wrapper, Mr. Jackson located a Notice of Patent Expiration issued September 24, 2007, and addressed to Computer Patent Annuities. (Paragraph 10 and Exhibit 3, Jackson Affidavit; Exhibit 2, Chesser Affidavit). This exhibit is the only evidence of any mailing of a Notice of Patent Expiration to anyone. (Paragraph 10, Jackson Affidavit; Paragraph 6, Chesser Affidavit). Mr. Jackson was unable to locate any other mailing of a Notice of Patent Expiration in the file wrapper except the one addressed to Computer Patent Annuities. (Paragraph 10, Jackson Affidavit). The Undersigned, Mr. Jackson, submits this Petition on Ten Stix's behalf at the request of Mr. Cranford.

Mr. Wilburn Chesser

Mr. Wilburn Chesser, of Arent Fox LLP, states in his affidavit that he has undertaken a thorough search of Arent, Fox LLP records for correspondence or other documents related to US Patent No. 6,609,975 and has located no such records. (Paragraph 2, Chesser Affidavit). It is Mr. Chesser's recollection that on or about August 10, 2006, Mr. Chesser was requested by Mr. Cranford to transfer all Ten Stix files to James Bindseil, Esq. then at the law firm of Lowe, Hauptman, Ham & Berner. (Paragraph 3, Chesser Affidavit).

Mr. Wilburn Chesser further states in his Affidavit that, upon the issuance of US Patent No. 6,609,975, in the August of 2003 time frame, it was the practice of the firm of Arent Fox Kintner Plotkin & Kahn, PLLC, with whom Mr. Chesser was then associated, to request that maintenance fee responsibilities be handled by Computer Patent Annuities, (later CPA Global), of Alexandria, Virginia. (Paragraph 4, Chesser Affidavit). Mr. Chesser states in his Affidavit that, to the best of his personal recollection, he had no knowledge of the expiration of US Patent No. 6,609,975 until learning of the expiration from Mr. Jackson's inquiry. (Paragraph 5, Chesser

Affidavit). Mr. Chesser's request to Computer Patent Annuities of Alexandria, VA to assume maintenance fee responsibilities for the '975 patent is evidenced by a Notice of Patent Expiration issued September 24, 2007, and addressed to Computer Patent Annuities. (Paragraph 6 and Exhibit 2, Chesser Affidavit). This exhibit is the only evidence of any mailing of a Notice of Patent Expiration to anyone. No other such Notice is in the retrieved file wrapper for US Patent No. 6,609,975. (Paragraph 10, Jackson Affidavit; Paragraph 6, Chesser Affidavit)

Mr. James Bindseil

Mr. Bindseil states in his Affidavit that he has conducted an investigation including inquiries of the following law firms for any files related to the '975 patent: Lowe, Hauptman, Ham & Berner (LHHB) (where he received Ten Stix files from Mr. Chesser) and Amin, Turocy & Calvin (now Turocy & Watson). (Paragraph 3, Bindseil Affidavit). Mr. Bindseil testifies that neither firm has any files. (Paragraph 3, Bindseil Affidavit). Mr. Bindseil's recollection is that he initially received any Ten Stix file at approximately the 3.5 year maintenance fee due date or sometime after August of 2006. (Paragraph 4, Bindseil Affidavit). Also, it is Mr. James Bindseil's recollection and upon information and belief, that the firm of Lowe, Hauptman, Ham & Berner did not send out any letters to Mr. Cranford or Ten Stix for paying the first maintenance fee during the maintenance fee window calculated above. (Paragraph 6, Bindseil Affidavit). Mr. Bindseil understood from Mr. Chesser that LHHB was not responsible for payment. It was Mr. Bindseil's understanding that Computer Patent Annuities was responsible for handling annuity correspondence with Ten Stix. (Paragraph 5, Bindseil Affidavit). Furthermore, it is Mr. Bindseil's recollection that the firm of Amin, Turocy & Calvin or Turocy & Watson also did not send out any letters to Mr. Cranford or Ten Stix during the period of time any file related to the '975 patent was in their possession. (Paragraphs 6 and 7, Bindseil Affidavit). To the extent any files of Ten Stix exist, Mr. Bindseil testifies that such files were transferred to the responsibility of the PCT Law Group approximately November of 2008, from the Turocy firm. (Paragraph 7, Bindseil Affidavit).

Consequently, it may be collectively understood from reading all affidavits and reviewing all exhibits thereto, that the delay in paying the maintenance fee due at 3 ½ years for US 6,609,975 was unavoidable because neither Mr. Cranford nor Ten Stix Gaming have no business

records nor personal recollection of ever being advised by Computer Patent Annuities that a fee was due.

Given these facts, Petitioner respectfully requests the enclosed maintenance fee be accepted and US Patent No. 6,609,975 reinstated from its expired state to full force and effect.

Applicant seeks a telephonic interview to discuss the present petition in the event that the Examiner of this Petition requires further evidence or assurance that the "unavoidable" standard has been met in the present circumstances as described above. Applicant respectfully requests action on this Petition before the 7 ½ year maintenance fee window opens August 26, 2010.

Respectfully submitted,

PCT Law Group

By:



Thomas H. Jackson (29,808)

818 Connecticut Avenue, N.W., Suite 700

Washington, D.C. 20006

Telephone: (202) 293-3559

Facsimile: (202) 280-1393

Dated: April 15, 2010

Attachments: Affidavit of Tony Cranford and Exhibit 1  
Affidavit of Thomas Jackson and Exhibits 1-3  
Affidavit of Wilburn Chesser and Exhibits 1-2  
Affidavit of James Bindseil